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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,143	08/20/2004	Stephen Watkins	056222-5059	5717
9629 7590 03/12/2007 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER ELHILO, EISA B	
			ART UNIT	PAPER NUMBER
			1751	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/12/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/505,143

Applicant(s)

WATKINS ET AL.

Examiner

Eisa B. Elhilo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4 and 6-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1 This action is responsive to the amendment filed on January 10/2007.

The cancellation of claims 1-3 and 5 is acknowledged. Pending claims are 4 and 6-11.

2 Claims 4 and 6-8 stand rejected under 35 U.S.C. 102(e) as being anticipated by Dubief et al. (US 6,190,676 B1) for the reasons set forth in the previous office action mailed on 10/13/2006.

#### New ground of rejection

#### *Claim Rejections - 35 USC § 103*

3 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubief et al. (US 6,190,676 B1).

Dubief et al. (US' 676 B1) teaches a process for treating and protecting hair by applying to the hair a composition comprising ceramide (see col. 8, lines 43-47) wherein the ceramide compounds are presented in the composition in the amounts of 0.005 to 3% which are effective amounts and overlapped with the claimed amounts as claimed in claims 9-11 (see col. 8, lines 18-22).

The instant claims differ from the reference by reciting a composition comprising specific percentage amounts of the ceramide compounds.

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However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to formulate such a composition for treating hair by optimizing the amounts of the ceramide compounds in the composition in order to get the maximum effective amounts of the ceramide compounds in the composition. Such a modification would be obvious because Dubief et al. (US' 676 B1) clearly teaches that the concentration of the ceramide compounds can be vary from 0.005 to 3% (see col. 8, lines 18-22) and wherein the amounts suggested by the reference are overlapped with the claimed amounts, and, thus a person of the ordinary skill in the art would expect such a composition to have similar properties to those claimed, absent unexpected results.

***Response to Applicant's Arguments***

4 Applicant's arguments filed 1/10/2007 have been fully considered but they are not persuasive.

With respect to the rejection of the claims under 35 U.S.C. 102(e) as being anticipated by Dubief et al. (US' 676 B1), Applicant argues that there is no explicit disclosure in Dubief et al. of a ceramide in a non-oxidative hair coloring composition. Applicant also argues that there is no functioning of ceramide to improve the coloring effects of non-oxidative hair coloring composition.

The examiner respectfully disagrees with the above arguments because the instant claims do not require a ceramide compounds to be part of the non-oxidative coloring composition. Therefore, the claims recite a method for applying a composition to the hair wherein the composition comprises ceraminde compounds.

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Further, the recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Furthermore, in order to constitute anticipatory prior art, a reference must identically disclose the claimed compound, but no utility be disclosed by the reference. *In re Schoenwald*, 964 F.2d 1122, 22 USPQ2d 1671 (Fed. Cir. 1992) (The application claimed compounds used in ophthalmic composition to treat dry eye syndrome. The examiner found a printed publication, which disclosed the claimed compound but did not disclose a use for the compound. The court found that the claim was anticipated since the compound and a process of making it was taught by the reference. The court explained "no utility need be disclosed for a reference to be anticipatory of a claim to an old compound." 964 F.2d at 1124, 22 USPQ2d at 1673. It is enough that the claimed compound is taught by the reference. Therefore, the rejection of the claims under 102(e) is proper and maintained.

5 Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Eisa Elhilo  
Primary Examiner  
Art Unit 1751

March 8, 2007